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REMARKS

Claims 1-8 were pending in the present application. Claims 1-5 and 8 have been canceled herein. Thus claims 6 and 7 are now pending. The applicant respectfully requests reconsideration and allowance of the present application in view of the above amendments and the following remarks.

Claims 1 and 3-5 stand rejected under 35 USC §102(b) as being allegedly anticipated by Hara, U.S. Patent No. 5,302,850 (hereinafter "Hara"). Claims 1-5 are canceled herein rendering the rejection moot.

Claims 1 and 2 stand rejected under 35 USC §103(a) as being allegedly unpatentable over Wensel, U.S. Patent No. 6,001,672 (hereinafter "Wensel"), in view of Hara. Claims 1 and 2 are canceled herein rendering the rejection moot.

Claims 6 and 8 stand rejected under 35 USC §103(a) as being allegedly unpatentable over Hara in view of Lemaire, et al., U.S. Patent No. 5,417,905 (hereinafter "Lemaire"). The rejection is respectfully traversed.

Applicants incidentally note that claim 6 is amended herein to include the limitations of claim 8.

In making the rejection, the Examiner has cited Lemaire in the applied art combination as allegedly teaching features of the claimed invention. In particular, the Examiner alleges that Lemaire teaches a resin-sealed semiconductor device including, *inter alia*, an injection mark of the resin *disposed directly above the surface of the semiconductor chip* and a recessed portion disposed in an end surface of the resin, wherein the top of the injection mark is made lower than the end surface. Applicants respectfully disagree and note that Lemaire at best teaches a credit card manufacturing process where a mark 770 may be found in a cavity 790 as shown in the drawings. Lemaire's description is notably silent regarding the placement of the cavity and mark

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and the relation of the mark to the cavity or the surface of the card, e.g. Lemaire fails to teach or suggest that the cavity and mark are disposed directly above the surface of a semiconductor chip and a recessed portion is disposed in an end surface of the resin, wherein the top of the injection mark is made lower than the end surface as claimed. Lemaire clearly shows, for example, in Figure 23a, that the injection nozzle is placed to the side of mold cavity 700, such that the cavity 790 and the mark 770 are to one side in the corner of the card as clearly shown in Figure 29a. Again, Lemaire fails to specifically describe the relation of the top of the mark 770 and the cavity 790.

Notwithstanding the deficiency in the teachings of the applied art combination, applicants further emphatically note that no evidence has been provided of a suggestion or motivation sufficient to guide one of ordinary skill in the art to combine Hara and Lemaire to arrive at the claimed invention. Strong contrary teachings are present in Lemaire which applicants contend would discourage one of ordinary skill in the art from combining the references. For example, in the semiconductor sealing mold of Hara, resin inflow openings are positioned *in symmetrical opposition*. The purpose of the specific placement of the resin inflow openings is to encapsulate a semiconductor element under the conditions of uniformly applied pressure to opposite surfaces thereof. The mold pressures thus extend outwardly in all radial directions *from the center of the semiconductor element*.

As noted above, Lemaire, at best, teaches a single inflow opening to the side and in the corner. Since providing resin inflow in such a manner produces non-uniform pressure, bosses 708 are required in Lemaire to ensure that the label 703 is pressed against the mold half 701. Accordingly, one of ordinary skill in the art practicing sealing a semiconductor element in accordance with Hara, e.g. by providing oppositely and symmetrically placed inflow openings so

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as to provide uniform pressure, would not look to Lemaire, which provides a single asymmetrical inflow opening leading to non-uniform mold pressures, for additional teachings.

Accordingly, for at least the reasons set forth hereinabove, a *prima facie* case of obviousness has not properly been established in that the applied art combination is improperly motivated and still fails to teach or suggest all the claimed features as required. It is respectfully requested that the rejection of independent claim 6 as amended be reconsidered and withdrawn.

Claims 6 and 7 stand rejected under 35 USC §103(a) as being allegedly unpatentable over Wensel, U.S. Patent No. 6,001,672 in view Hara and Lemaire. The rejection is respectfully traversed.

Claim 6 is amended herein to include the features of claim 8 and is believed allowable for at least the reasons set forth hereinabove.

With regard to the combination of Wensel and Hara, no evidence has been provided of a suggestion or motivation contained in the references, that would motivate one of ordinary skill in the art to make the combination. Applicants note that Wensel specifically teaches that encapsulant flow in mold cavity 44 is non-uniform (see, e.g. col. 4, line 37). Since Hara, as noted above, is concerned with providing uniformity in mold pressures, one of ordinary skill in the art would not have been motivated to make the combination of Wensel and Hara.

In response to the Examiner's carefully considered remarks regarding the reasons for combining Lemaire with the other references, applicants note that the claimed placement of the injection mark is specifically described for example on page 12, lines 20-25 of Applicants's specification. Thus the claimed placement is not an incidental aspect of the present invention. Accordingly, applicants believe that the addition of Lemaire in combination with the other references for the purpose of showing generally that injection marks commonly result is an insufficient basis to support the combination and to teach or suggest the claimed placement, for

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example for the reasons set forth herein above. Applicants note that while Lemaire may contain teachings of a general nature, it is unsuitable as a secondary reference to teach specific features of the claimed invention particularly given the contradictory nature of Lemaire's teachings in view of the teachings of the primary reference as noted above, and the corresponding lack of evidence of a suggestion to combine.

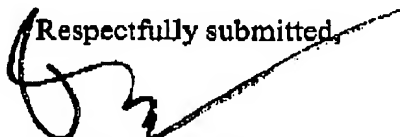
Accordingly, for at least the reasons set forth hereinabove, a *prima facie* case of obviousness has not properly been established in that the applied art combination is improperly motivated and still fails to teach or suggest all the claimed features as required. It is respectfully requested that the rejection of independent claim 6 as amended be reconsidered and withdrawn.

Claim 7, by virtue of depending from independent claim 6, as amended, is allowable for at least the reasons set forth hereinabove. It is respectfully requested therefore that the rejection of claim 7 be reconsidered and withdrawn.

In view of the foregoing, the applicant respectfully submits that the present application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,



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